REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested. Entry of this Amendment under Rule 116 is merited as it raises no new issues and requires no further search.

Several claims have been amended to better define the claimed invention. New claims 12-17 readable on the elected invention/species have been added to provide Applicants with the scope of protection to which they are believed entitled. The amended/new claims find solid support in the original specification and drawings. No new matter has been introduced through the foregoing amendments.

The *35 U.S.C. 112, second paragraph* rejection of claim 7 is believed overcome in view of the above amendments.

The Examiner's observation regarding the foreign priority is noted. Although Applicants do not necessarily agree with the Examiner's position, amendments have nevertheless been made to claims 2, 4, and 5 as that the amended claims now find positive support in the priority application as detailed in the previous Amendment.

The *35 U.S.C. 103(a)* rejection of claims 2, 4 and 5 over *Rothschild* should be withdrawn, because the reference is no longer qualified as prior art in view of the above amendments and discussion regarding the priority claim.

The new *35 U.S.C. 103(a)* rejection of claims 1-9 is noted. Basically, the Examiner is now relying on a new piece of art, i.e., *Viral Marketing*, as teaching the basic idea of awarding the *sender* for emails that he/she sent. The Examiner is further relying on another new piece of art, i.e., *Goldhaber*, as teaching the basic idea of awarding the *receiver* for emails that he/she viewed. The Examiner also uses official notice as a third piece of art that it was well known in the art to

provide advertisements as attachments. The Examiner finally concludes that it would have been obvious to combine the three pieces of art to arrive at claimed invention, with the opened/unopened advertising attachment being readable on the claimed convertible advertisement.

Applicants note that, even if the references are properly combinable in the manner proposed by the Examiner, which Applicants contend to the contrary, they would still fail to teach or suggest all features of the claimed invention. Specifically, the *Viral Marketing* reference discloses *no active* role of the sender. The term "viral" strongly indicates that the service is spread like a virus, i.e., without any active participation of the sender. *See* also page 2, lines 1-3 from bottom of the reference, i.e., the service is spread involuntarily and the endorsement from a friend is only implied. Therefore, the primary reference, singly or in combination with the other teaching reference(s), does not teach or suggest the step of choosing an advertisement among a plurality of available advertisements as recited in claim 5, and now in independent **claim 3** as presented above. The step of choosing positively defines the transmitting part's active involvement in the advertisement selection which is neither disclosed, taught nor suggested by *Viral Marketing*.

Another distinction resides in the manner the advertisement is activated/deactivated as defined in amended independent **claim 1**. The Examiner's attachment/advertisement, if considered to be readable on the claimed advertisement, would not teach or suggest the claimed activating member (which finds support at button 48 in FIG. 3) provided separately from the advertisement and also included in the email. Independent claim 1 is thus patentable over the applied art of record.

The dependent claims, including any new claim(s), are considered patentable at least for the reason(s) advanced with respect to the respective independent claim(s).

The new claims are all believed to be patentable over the art, because the art, especially the primary reference, does not fairly teach or suggest the activating member as defined in the new claims.

Accordingly, all claims in the present application are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under *37 C.F.R. 1.136* is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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